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Greg B. Hale

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EXAMINER

BUI, KIEU OANH T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,513	Applicant(s) HALE ET AL.	
	Examiner KIEU-OANH BUI	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-44 and 46-79 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-44, 46-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/05/07 has been entered.

Response to Amendment

2. The declaration filed on 11 September 2006 and on June 05 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Karstens reference. Responsive to the Final Rejection (mailed 10 July 2006), applicants have submitted a new declaration pursuant to 37 C.F.R. 1.131 in order to overcome the Karstens (US Pub No. 2004/0044532 A1) reference. Applicant's arguments in conjunction with the declaration and corresponding evidence generally set forth that conception occurred prior 03 September 2002 (Paragraphs 1 and 4-5; Exhibits A-B) and that applicants were diligently working to constructively reduce the invention to practice from prior to 03 September 2002 to the filing of the provisional application filled on 25 October 2002 (Paragraphs 1, and 7-15; Exhibits C-I). Exhibit C appears to be a communication on 19 September 2002 between Christopher Darrow and Donald Wenskay providing a status update on various patentability reports. Exhibits D-G are communications on 14 October

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2002 between the inventors and Margo Maddux and Exhibits H-I are further communications between the inventors and Margo Maddux regarding the draft provisional application.

In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence and the USPTO will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970). An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 9201 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue). The provided evidence comprises a number of gaps that fail to account or provide a showing for the entire period in which diligence is required.

There is no evidence supporting applicant's statement of diligence from just prior to 03 September 2002 continuously through 18 September 2002 (Exhibit C - 19 September 2002), from 20 September 2002 - 13 October 2002 (Exhibits D-G - 14 October 2002), and from 15 October 2002 - 22 October 2002 (Exhibits H-I - 23 October 2002). Applicants need to provide evidence or acceptable excuses of their continued diligence and particular activities/inactivity for each and every day throughout the critical period in order to support their statement. Accordingly, the evidence submitted is

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insufficient to establish diligence from a date prior to the date of reduction to practice of the Karstens reference to a constructive reduction to practice.

Applicant's supplied evidence also appears to rely upon the examiner to speculate what is specifically being shown or not shown and does not clearly establish an evidentiary timeline of particular activities being conducted related to the constructive reduction of practice of the invention. Exhibits A-B illustrate an invention disclosure statement being provided to Don Wenskay circa 19 April 2002. Exhibits D-G make reference to an updated disclosure being sent to Don Wenskay circa 30 May 2002. Exhibit C appears to illustrate a status report provided on 19 September 2002. However, it is unclear as to how/why Exhibit C is actually evidence regarding the constructive reduction to practice for the claimed invention given that it is merely a status report referencing the generation of patentability reports. Conducting a search in order to determine whether or not to pursue the filing of a patent patentability of does not appear to be directly related to either the actual or constructive reduction of practice of the invention. It is not even clear that the information referenced therein relates to the instant application as opposed to other related or similar projects. Exhibits D-G further set forth that on 10 October 2002 (and 14 October 2002 - due to computer issues) that an updated disclosure was provided. There is no indication to what activities related to the reduction to practice were being performed between the status report on 19 September 2002 (Exhibit C) and the inventors providing the updated disclosure on 10 October 2002. The email communication by Phu Nguyen on 30 May 2002 in Exhibits D-G raise additional questions. In particular, the attached message states that the earlier draft of 19 April 2002 (which was relied upon for evidence of conception in Exhibits A-B) does not

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contain the features that make the invention unique. The non-elected embodiment (Non-Final Rejection - 23 September 2004) pertaining to the usage of a 'profile' appears to be the newly added subject matter between revisions. Is the examiner to conclude that per applicant's own admission that the subject matter disclosed and relied upon as evidence of conception is not actually unique/patentable and that only the additional subject matter contained in revision 3 should be considered inventive? Furthermore, the first draft of the provisional patent application appears to have been sent to the inventors for review on 22 October 2002 as evidenced by Exhibits H-I. However, there is no statement or evidence regarding reasonable attorney diligence with respect to the time needed to prepare the provisional application throughout the entire critical period.

Finally, as noted by the examiner, during the critical period from 7/31/02 to 10/09/02 (as submitted and evidenced in Exhibit 9), only search for related provisional applications were performed, and then there was a long break until 10/09/02, only the invention disclosure was being reviewed, and importantly, the draft provisional application was then LOCATED on that date, and the works on FILING the provisional application was firstly performed.

To support the examiner's statement, the examiner would like to extract some important highlights from a case law (applicable to the same situation like this now) in Case Gould V. Schawlow and Townes (150 USPQ 634 Decided Aug. 4, 1966 App No. 7511), the examiner notes some issues as follow:

[4] Interference-Diligence - In general (► 41.251)

Applicant's statement that there were no weeks or months that he did not work on involved invention is not enough to show diligence, absent supporting facts showing specifically what that work consisted of and when it was performed.

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[5] Interference - Diligence - In general (► 41.251)

Something more than mere conversation or keeping an idea under consideration is required to constitute diligence.

.....

Toward the end of September 1958, Gould first informed Dr. Goldmuntz of his ideas concerning the laser, and was subsequently assigned to write, on company time, a proposal * describing the device and methods of building it. By the middle of December 1958, the proposal was completed and submitted to various government agencies and Aerojet General Corporation for evaluation. The Advanced Research Projects Agency subsequently awarded TRG a research contract totaling nearly a million dollars for development of the subject matter of the proposal.

* While that proposal is not part of the present record, testimony shows that it describes various laser devices, as well as many systems incorporating laser devices.

Summarizing his activities over the period November 1957 to December 1958, Gould estimated he spent "approximately a thousand hours" acquiring the knowledge which enabled him to devise the ideas expressed in

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Exhibit 9, and that there were no months or weeks during that period in which he did not "work on the laser."

In commenting on Gould's evidence of diligence, the board stated:

* * * we do not find that a sufficient account has been made of the critical period so that we can assure ourselves that no unexplained lapse appears therein. Occurrences such as Gould's failure to participate in the reconditioning of his boat in the spring of 1958, and conversations such as those with co-worker Newstein at TRG, Inc. and with Dr. Alan Berman at beach parties in May and August, 1958 do not corroborate specific significant acts directly related to giving the invention a physical embodiment. Such evidence is far too fragmentary, and leaves to mere inference that Gould was actively engaged in reducing the invention to practice during this crucial period. We are not prepared to make this inference.

[3] Nor are we. Even were we to disregard for the moment the necessity for corroboration and thus give Gould's testimony the full weight to which properly corroborated testimony in an interference is entitled, we find the testimony in and of itself insufficient to adequately establish *what* Gould did and *when* he did it. Little attempt has been made to identify particular activity with particular times during the critical period of concern-July to December 1958 and especially July, August and September 1958 - or to establish how such activity related to reducing to practice the subject matter of the counts. In our view, Gould's testimony taken as a whole does not set forth adequate facts to support a finding of that continuity of activity which constitutes reasonable diligence.

[4] Merely stating that there were no weeks or months that he "did not work on the laser" is not enough, absent supporting facts showing specifically what that "work" consisted of and when it was performed.

[5] Much of Gould's more detailed testimony, as summarized above, relates to the period November 1957 to March 1958. Apart from his general assertions that there were no weeks or months in 1958 that he did not work on the laser, we find the only relevant activities from July to September 1958 referred to by Gould are his acts of taking off

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from work at TRG in those months and his discussion with Dr. Berman in August. * Gould asserts the board erred in basing its decision as to the question of diligence in part on the extent to which Gould took days off from TRG to record his ideas in

* We agree with the board that Gould has not shown the relevance of the August conversation with Dr. Berman to reducing the laser of the counts to practice or overcoming obstacles in the way of a reduction to practice. Something more than mere conversation or keeping an idea under consideration is required to constitute diligence. See *Cottrell v. Shafer*, 25 CCPA 1171, 97 F.2d 121, 37 USPQ 726.

[6] Exhibit 9. **While reasonable diligence does not require that one abandon his means of livelihood to further his reduction to practice, it was incumbent upon Gould, if he intends to rely on the taking of time from his normal employment as acts of diligence, to establish *what* was done and *when* it was done.** Merely stating, for example, that he took off 6 1/2 days in July, 2 days in August, and 3 days in September does not enable us to ascertain the extent of time gaps in his activity. The months of July and August, bracketing Schawlow's entry into the field, are critical to Gould's case, and a lapse of nearly two months would result if 6 1/2 days were taken at the start of that period and the 2 days at the end. The party chargeable with diligence must account for the entire period during which diligence is required. Gould has not done so here. As in *Ireland v. Smith*, 25 CCPA 1258, 97 F.2d 95, 37 USPQ 807, 811:

We may surmise that appellant was probably diligent * * * but mere surmise cannot take the place of proof * * *.

Response to Arguments

3. Applicant's arguments filed 11 September 2006 and June 5 2007 have been fully considered but they are not persuasive.

Applicant's remarks concerning the rejection of claims 22-44 and 46-79 over claims 1, 2, 16-18, 21, 22, and 30-32 of US Pat No. 6,785,539 and the filling of a terminal disclaimer pending indication of allowable subject matter is acknowledged.

Applicant's remarks and declaration under 37 C.F.R. 1.131 regarding the rejection of claims 22-44 and 46-79 in view of the Karstens reference is acknowledged and similarly not found to be persuasive as discussed. The office action stands and is repeated as previously stated.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless -
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

5. Claims 22, 24-34, 36-44, 46-49, 52-75, and 78-79 are rejected under 35 U.S.C. 102(e) as being anticipated by Karstens (US Pub No. 2004/0044532 A1).

In consideration of claim 22, the Karstens reference discloses a "method of providing content data to a viewer of a media presentation in conjunction with the media presentation" (Figure 1). The method comprises "providing a viewer of the media presentation" [175] with a "portable device" [100] that is "remote from the presentation of the media presentation", as illustrated, and is "capable of receiving wireless communications (Para. [0049]) and "displaying content data relating to the media presentation" (Figures 6A/B; (Para. [0016] -[0018])). As illustrated in Figures 2 and 4, the "portable device" [100] "accumulates content data in the cache memory" [330]. The media playing device [425], "transmits at least one time prompt to the portable device" [210] "triggering the content data to be displayed on the portable device" (ex. [260]) such that the "content data is displayed in synchronization with the presentation of a

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corresponding portion of the media presentation". Subsequently, the

"portable device" [100] "displays the content data" (Para. [0038] - [0047]).

Claim 46 is rejected as aforementioned wherein the Karstens reference discloses a "method of interactive communication during a media presentation" (Figure 1). The method comprises "presenting the media presentation at a first location" [120] "using media presentation data" associated with enhanced captioning content wherein the "media presentation data has at least one time code associated with the media presentation data" (Para. [0043] and [0049]). A "viewer of the media presentation" [175] is "provided... with a portable device" [100] wherein the aforementioned "viewer is located at a location remote from the first location" as illustrated in Figure 1. As illustrated in Figures 2 and 4, the method involves "transmitting the media presentation data to the portable device and caching the media presentation data in cache memory" [330]. "While the media presentation is being presented", the portable device "detects one of the at least one time codes associated with the media presentation data" and "determines when the media presentation data should be displayed based on the contents of the at least one time code". Subsequently, the portable device [100] "displays the media presentation data., in relative synchronization with the presentation of a corresponding portion of the media presentation" (Para. [0038] - [0047]).

In consideration of claim 47, the Karstens reference discloses a "method of providing content data to a viewer of a media presentation in conjunction with the media presentation" (Figure 1). The method comprises "providing a viewer of the media presentation" [175] with a "portable device" [100] comprising "at least two receivers" (associated with the particular distribution of synchronization information and enhanced

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content data (Para. [0049] -[0053])) and "capable of presenting content data relating to the media presentation to the viewer in conjunction with the media presentation" (Figures 6A/B; (Para. [0016] - [0018])).

As illustrated in Figures 2 and 4, the method involves "transmitting the content data to the portable device using first receiver signals" (ex. formatted wireless or Internet receiver signals) "at the start or slightly in advance of the start of the media presentation" (Para.[0016], [0034] and [0042]) whereupon the "portable device" [100] "accumulates content data in the cache memory" [330]. The media playing device [425] "transmits at least one message to the portable device using second receiver signals" (ex. audible or wireless formatted signals" which "identify a time when the content data should time prompt to the portable device such that the content data and a corresponding portion of media presentation are displayed in synchronization" [210]. Subsequently, the "portable device" [100] "presents the data., to the viewer in synchronization with the media presentation" (Para. [0038] - [0047])).

In consideration of claim 48, the Karstens reference discloses a "method of providing content data to a viewer of a media presentation in conjunction with the media presentation (Figure 1). The method comprises "providing a viewer of the media presentation" [175] with a "portable device" [100] comprising "at least two receivers" (associated with the particular distribution of synchronization information and enhanced content data (Para. [0049] - [0053])) and "capable of displaying content data relating to the media presentation" (Figures 6A/B; (Para. [0016] - [0018])). As illustrated in Figures 2 and 4, the method involves "transmitting the content data to the portable device using first receiver signals" (ex.formatted wireless or Internet receiver signals) (Para. [0016],

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[0034] and [0042]) whereupon the "portable device" [100] "accumulates content data in the cache memory" [330]. The media playing device [425] "transmits at least one time prompt to the portable device using second receiver signals" (ex. audible or wireless formatted signals" which "identify a time when the content data should time prompt to the portable device such that the content data and a corresponding portion of media presentation are displayed in synchronization" [210]. Subsequently, the "portable device" [100] "executes the content data..., in synchronization with the media presentation" (Para. [0038] - [0047]).

In consideration of claim 54, the Karstens reference discloses a "method of providing a viewer of a first media content with a second media content" (Figure 1). The method comprises "providing a viewer of the first media content" [175] with a "portable device" [100] that is "remote from a display of the first media content", as illustrated, and is "capable of receiving wireless communications (Para. [0049]) and "displaying the second media content" (Figures 6A/B; (Para. [0016] - [0018])). As illustrated in Figures 2 and 4, the method "transmits the second media content to the portable device" [245]. The media playing device [425] "transmits at least one time prompt to the portable device" [210] "triggering a display of the second media content on the portable device" (ex. [260]) such that the "second media content and a portion of the first media content are displayed in synchronization". Subsequently, the "portable device" [100] "displays the second media content..., at a time indicated by the time prompt" (Para. [0038] - [0047]).

In consideration of claim 59, the Karstens reference discloses a "method of providing a viewer of a first media content with a second media content" (Figure 1). The method comprises "providing a viewer of the first media content" [175] with a "portable

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device" [100] that is "remote from a display of the first media content", as illustrated, and is "capable of receiving wireless communications (Para. [0049]) and "displaying the second media content.., being different from the first media content [and] associated with a portion of the first media content" (Figures 6A/B; (Para. [0016] - [0018]). As illustrated in Figures 2 and 4, the method "transmits the second media content to the portable device" [245]. The media playing device [425] "transmits a time prompt to the portable device" [210] "triggering a display of the second media content on the portable device" (ex. [260]) such that the "second media content and a portion of the first media content are displayed in synchronization". Subsequently, the "portable device" [100] "displays the second media content.., at a time indicated by the time prompt" (Para. [0038] - [0047]).

Regarding claim 65, the Karstens reference discloses a "method of providing a viewer of a first media content with a second media content" (Figure 1). The method comprises "providing a viewer of the first media content" [175] with a "portable device" [100] that is "remote from a display of the first media content", as illustrated, and is "capable of receiving wireless communications (Para. [0049]) and "displaying the second media content" (Figures 6A/B; (Para. [0016] - [0018]). As illustrated in Figures 2 and 4, the method "transmits the second media content to the portable device" [245]. The media playing device [425] "transmits a time prompt to the portable device" [210] "triggering a display of the second media content on the portable device" (ex. [260]) such that the "second media content and a portion of the first media content are displayed in synchronization". The "portable device" [100], which further "provides inputs on the portable device adapted to receive information from the viewer" (Para. [0037] and

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[0044]) subsequently, "displays the second media content... at a time indicated by the time prompt" (Para. [0038] - [0047]).

Claim 24 is rejected wherein the "content data is transmitted by way of radio frequency signal" (Para. [0042] and [0043]).

Claims 25-27 are rejected wherein the "media presentation data comprises a combination of audio and video data" or is "audio data" or is "video data" corresponding to the particular media presented during the particular type of event attended by the user (Para. [0030] and [0067]).

Claims 28, 30, and 31 are rejected wherein the "content data comprises a combination of audio and video data" or "video" or "audio" wherein the particular enhanced closed captioning stream [160] is both "video" or "video data" in that it is rendered on a video display and may further describe actions occurring in the video (Para. [0066]) and is a form "audio" or "audio data" in so far as it serves to describe or be representative of the audio of the presentation that is displayed (Figure 6A/B).

Claim 29 is rejected wherein the "content data comprises text" (Para. [0033]).

Claim 32 is rejected wherein the "content data comprises graphics" (Para. [0033]).

Claims 33 and 34 are rejected wherein the "at least one time prompt is representative of a time of day" associated with or "representative of a time at which the media presentation starts" (Para. [0037] and [0038]).

Claim 36 is rejected wherein the "portable device comprises a display" [360] (Figure 3).

Claim 37 is rejected wherein the "portable device is a personal digital assistant" (Para. 0048]).

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Claim 38 is rejected wherein the "portable device is a cellular phone" (Para. [0049]).

Claims 39 and 40 are rejected wherein the "media presentation is a pre-recorded presentation" that is a "movie" (Para. [0030]).

Claim 41 is rejected wherein the "pre-recorded presentation is a movie and the content data is text captioning" (Para. [0030]).

Claim 42 is rejected wherein the "pre-recorded presentation is a movie and the content data comprises descriptive audio for the blind" (Para. [0030] and [0066]).

Claim 43 is rejected wherein the "content data is a visual narrative..., being displayed in one of a plurality of languages" (Para. [0033]).

Claim 44 is rejected wherein the "content data is an audio narrative..., being played in one of a plurality of languages" (Para. [0067] and [0067]).

Claims 49, 55, 60, 71, 73, and 75 are rejected wherein the method "further provides inputs on the portable device adapted to receive information from the viewer" (Para. [0037] and [0044]).

Claims 52 and 78 are rejected wherein the "time prompt further identifies the content data to be presented at the portable device" (Para. [0039]).

Claims 53, 64, 68, 70, 74, and 79 are rejected wherein the "content data is transmitted to the portable device at the start or slightly in advance of the start of the media presentation" (Para. [0016], [0033] - [0035], and [0042]).

Claims 56, 62, and 67 are rejected wherein the method further comprises "accumulating the second media content in the cache memory of the portable device" (Para. [0033] and [0068]).

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Claims 58, 61, 66, and 69 are rejected wherein the "first media content is live" (Para. [0005], [0006], [0014], and [0030]).

Claim 63 is rejected wherein the "second media content is related in content with a portion of the first media content" (Para. [0030]).

Claim 72 is rejected wherein the method further comprises "determining what portion of the media presentation data should be displayed based on the contents of the at least one time code" (Figures 2 and 4).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 23, 35, 50, 51, 76, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karstens (US Pub No. 2004/0044532 A 1), in view of Applicant's admission of fact (APA).

In consideration of claim 23, the reference suggests that the "at least one time prompt" may be transmitted as a wireless signal (Para. [0034]) but it is silent with respect to the wireless signal being "by way of infrared signal". Applicant's admission of fact provides evidence that it is well known and expected to use IR to transmit data to devices. Accordingly, it would have been obvious to one having ordinary skill in the art so as to "transmit [the at least one time prompt] by way of infrared signal" for the purpose of utilizing an inexpensive, simplistic way of sending data wirelessly.

In consideration of claim 35, the Karstens reference is silent with respect to the nature of the portable device such that the portable device [100] such that the described PDA, mobile telephone, or computer (Para. [0048]) comprises speakers. Applicant's admission of fact (APA) provides evidence that it is notoriously well known in the art for portable devices to "comprise speakers". Accordingly, it have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the aforementioned portable devices [100] to further "comprise speakers" for purpose of providing a means to reproduce audio signals in stereo.

In consideration of claims 51 and 77, it is unclear if the portable device [100] further comprises a "transceiver". Applicant's admission of fact provides evidence as to the existence and usage of "transceivers" in portable devices. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to provide a "transceiver" within the portable device [100] for the purpose of

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advantageously supporting bi-directional communications between the personal device [100] and external networks.

In consideration of claims 50 and 76, as aforementioned, the reference discloses the particular usage of a wireless signal to distribute both the timing (Para. [0036]) and the content related to the media presentation (Para. [0049]). While the reference clearly discloses the usage of a "radio frequency receiver", the reference is silent with respect to the particular usage of an "infrared receiver". Applicant's admission of fact provides evidence that it is well known and expected in the art to use RF and IR to transmit data to devices. Accordingly, it would have been obvious to those having ordinary skill in the art at the time the invention was made so as to modify the portable device [100] such that the "at least two receivers are an infrared receiver and a radio frequency receiver" for the purpose of providing an inexpensive, simplistic way of sending data wirelessly.

Conclusion

8. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. **Any response to this action should be mailed to:**
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to PTO New Central Fax number:
(571) 273-8300, (for Technology Center 2600 only)

Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/KIEU-OANH BUI/
Primary Examiner, Art Unit 2623